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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,432	09/15/2003	Michiyo Fujikawa	4618-002	1556

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EXAMINER	
SALVATORE, LYNDA	
ART UNIT	**PAPER NUMBER**
1771	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/663,432	FUJIKAWA ET AL.	
	Examiner	Art Unit	
	Lynda M. Salvatore	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/15/03,4/21/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 is indefinite because it appears that Applicant is attempting to claim an absorbent composite and a liquid. However, it appears that Applicant's composite is merely capable of transferring liquid. For purposes of examination claim 1 will be treated as such.

4. Claim 5 is indefinite because it is not clear what Applicant is attempting to claim with the phrase "with taking said surface of said first layer as a skin contacting surface". If Applicant intends for the first layer to be positioned on the skin contacting side then it is suggested to positively set forth such limitations.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being obvious over Suzuki et al., EP 0 841 156 A1.

The published European patent application issued to Suzuki et al., teaches a composite sheet comprising a first melt-blown thermoplastic non-woven layer (A) and a second cellulosic/thermoplastic non-woven layer (B) (Page 4,30-35 40-50 and Page 5, 5-10). Suzuki et al., teaches joining layers (A) and (B) by bonding with heat and pressure such that layers are sintered together (Page 3, 21-27 Page 9, 20-30 and Figure 1). With regard to the entangling limitations, said limitation is considered a method limitation not germane to the final product structure, however, Suzuki et al., teaches forming the non-woven layers by carding, spunbonding and entangling (Page 7, 22-35, Page 8, 20-25,Page 15, 40-43, Page 19, 15-20). Suzuki et al., teaches that liquid easily diffuses from the first porous layer and is absorbed in the second layer (Page 10, 49-54). However, said limitation is treated as a "capable of" limitation. It has been held that the recitation that an element is "capable of" of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138

With specific regard to claim 2, Suzuki et al., does not exemplify providing a second layer with 20-80% cellulose fibers but does teach a second layer comprising 30% thermoplastic fibers and 70% rayon (Page 23, 25-30). As such, it is the position of the Examiner that though not necessarily exemplified it would have been obvious to a skilled worker in the art to form the second layer with the claimed amount of cellulose fibers.

With specific regard to claim 3, Suzuki et al., does not specifically teach heat rolling the first layer such that surface is smooth, however, Suzuki et al., does teach heat and pressure (Figure 1). As such, it is the position of the Examiner that the claimed method of heat rolling is not considered germane to the final product since it appears that the prior art composite and the

claimed composite are the same or similar though produced by a different method. The presence of process limitations on product claims, in which the product does not otherwise patentably distinguish over the prior art, cannot impart patentability to the product. *In re Stephens*, 145 USPQ 656. In the instant case, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,292

With respect to claim 4, Suzuki et al., does not teach the density of each layer, however, it is the position of the Examiner that Applicant is not positively claiming the density of each layer. Rather, Applicant is claiming the density in terms of when a predetermined amount of pressure is applied. In other words, Applicant is attempting to claim the future density of each layer under pressure rather than positively setting forth the actual density of each layer. Absent such limitations, it is not possible to determine the scope of the claim in the present tense.

With regard to claim 5, Suzuki et al., teaches employing the composite sheet as an absorbent body and can be further combined with a back sheet on the back side of the second porous layer (Page 10, 58-Page 11, 2).

7. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 103(a) as being obvious over Butterworth et al., US 4, 081,582.

The patent issued to Butterworth et al., teaches a composite comprising a first entangled fibrous non-woven layer comprising cellulose and thermoplastic fibers (Column 4, 54-56, Column 5, 60-Column 6, 10). Said composite further comprises a second non-woven layer comprising thermoplastic synthetic wood pulp fibers (Column 1, 34-44, Column 2, 29-35). Butterworth et al., teaches joining the layers together with heat in the absence of pressure

(Abstract, Column 3, 1-10, and Column 10, 15-25). With regard to the recited liquid transfer limitation, Butterworth et al., teaches employing the composite in variety of personal care disposable articles (Column 5, 1-6). As such, it is the position of the Examiner that when the composite is subjected to liquid insult, said liquid would transfer through the layers. In addition, said limitation is treated as a "capable of " limitation. It has been held that the recitation that an element is "capable of" of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138

With regard to claim 2, Butterworth et al., does not specifically teach the claimed amount of cellulose fibers, however, it would be obvious to one having ordinary skill in the art to provide said first layer with a suitable amount of cellulose fibers and thermoplastic fibers to achieve a desirable balance of absorbent and bonding properties.

With respect to claim 4, Butterworth et al., does not teach the density of each layer, however, it is the position of the Examiner that Applicant is not positively claiming the density of each layer. Rather, Applicant is claiming the density in terms of when a predetermined amount of pressure is applied. In other words, Applicant is attempting to claim the future density of each layer under pressure rather than positively setting forth the actual density of each layer. Absent such limitations, it is not possible to determine the scope of the claim in the present tense.

With regard to claim 5, Butterworth et al., teaches employing the composite in a diaper comprising a back sheet (Column 12, 33-40, 49-51 and Figure 13).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 15, 2005
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